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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,165

08/29/2004

Jenny Wang

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11/19/2008

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION

P.O. BOX 506

MERRIFIELD, VA 22116

EXAMINER

JARRETT, SCOTT L

ART UNIT

PAPER NUMBER

3624

NOTIFICATION DATE

DELIVERY MODE

11/19/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/711,165	Applicant(s) WANG ET AL.	
	Examiner SCOTT L. JARRETT	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/06, 6/16/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed August 29, 2004. Currently claims 1-20.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and Method for Determining When a Business Trip Electronic Form is Continuous.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-20 are rejected under 35 U.S.C. 101 because

Regarding Claims 1-14, Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 9-14 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical

limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Regarding Claims 1-20, claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as currently recited, appear to be directed to a compilation of data without any tangible result and are therefore deemed to be non-statutory while the compilation of data may have some real world value (i.e. utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any “acts” which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations

preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (Abele, 684 F.2d 902, 907, 214 USPQ 682, 687(CCPA 1982)). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2d at 1452 and State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claims 1-20 merely recite a method/system for collecting and comparing electronic form data (i.e. useful and concrete). While the invention may be concrete and/or useful, there does not appear to be any tangible result.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al., U.S. Patent No. 6,442,526 in view of Head 101 Common Indicators of Errors (2001).

Regarding Claims 1 and 15, Vance et al. teach a system and method of operating an electronic form system comprising (Figures 2, 4, 8, 10, 13):

- receiving a business trip electronic form inputted from a user (Column 5, Lines 1-16; Figure 3, Element 68; Figure 4, Element 84, 120; Figure 2, Element 40, 50);
- analyzing the business trip record and matching business trip request form against business rules (policies, constraints, etc.; Column 2, Lines 15-24, 49-54; Column 6, Lines 40-55; Column 7, Lines 10-47; Column 11, Lines 14-19; Figures 8, 10, 13); and
- storing the business trip record (Figures 2, 13, Element 128).

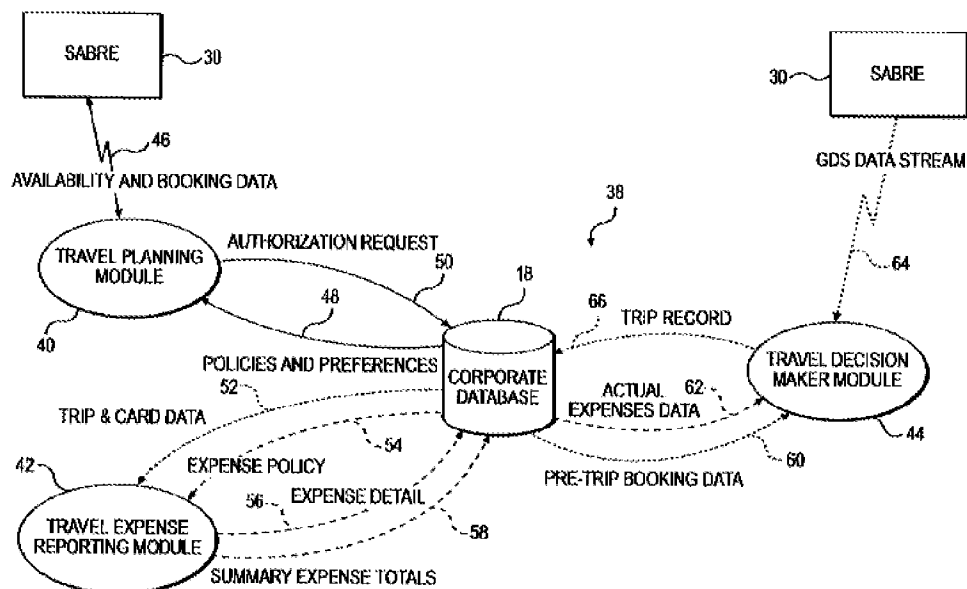


FIG. 2

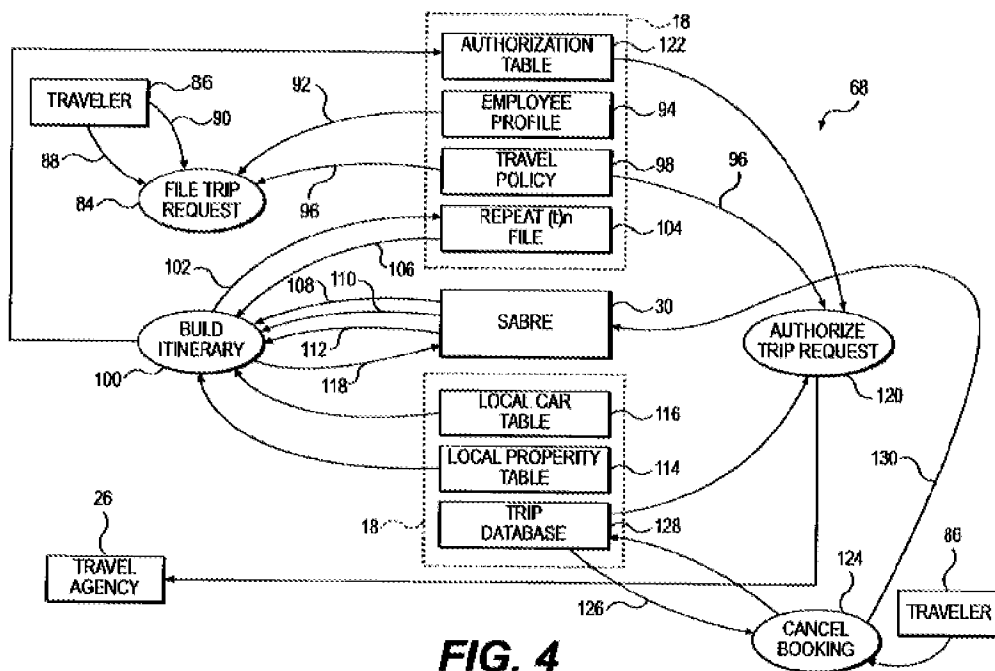


FIG. 4

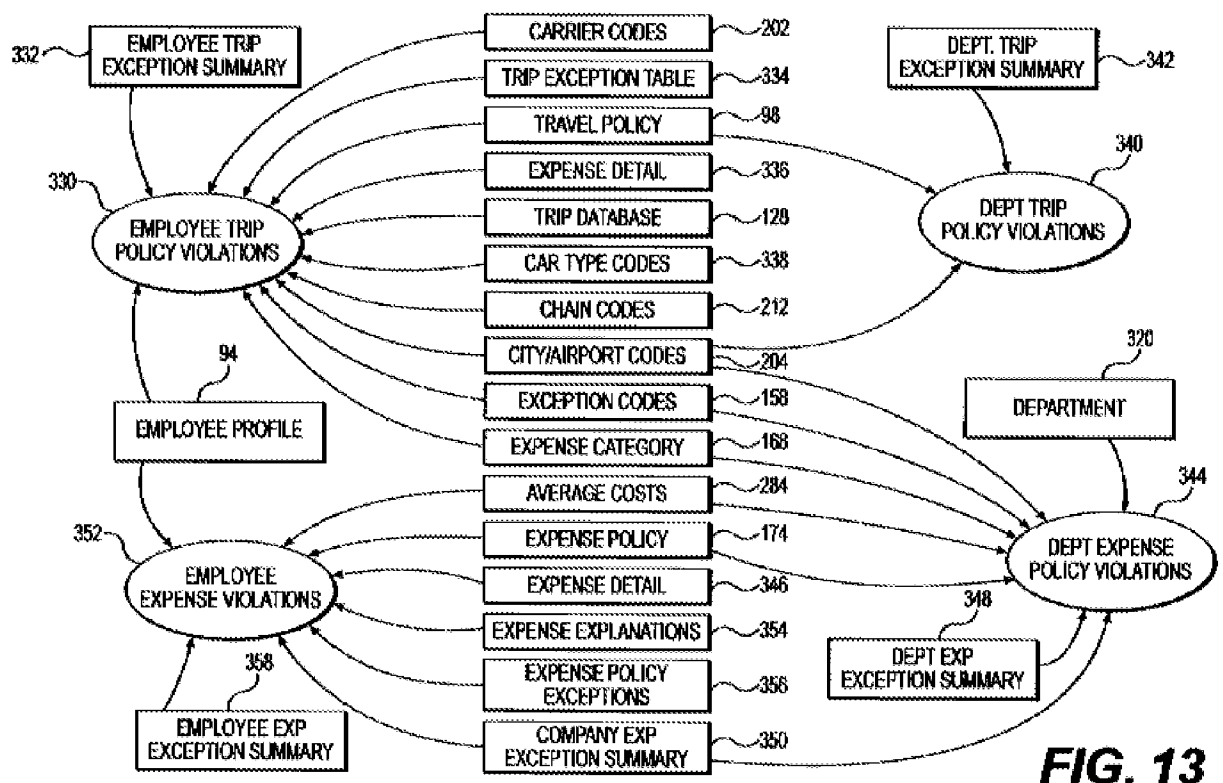


FIG. 13

While checking travel dates for continuity (e.g. start date less than end date, duplicate dates, etc.) is old and well known Vance et al. does not expressly teach - determining whether a predetermined business trip period recorded by the business trip electronic form is continuous as claimed.

Head teaches a plurality of well known business policies/rules used to detect incorrect, inaccurate and/or fraudulent information in a business specifically Head teaches determining whether a predetermined business trip is continuous (Numbers 8,

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13, 16, 34, 37) in an analogous art of business management for the purposes of catching common accounting/business errors.

TRAVEL

Duplicate Claims

- 32) Claims for personal mileage and rental car
- 33) Claims for meals, hotel, airfare charged to corporate credit card
- > 34) Overlapping travel dates

Fraudulent Claims

- 35) Gasoline charges for personal use (more than one vehicle in same day)
- 36) Consecutively numbered meal or hotel receipts
- > 37) Same receipts (airline, hotel, meal, etc.) submitted a few months apart
- 38) Frequent travel to same location, not a branch location
- > 39) Travel at Holiday times
- > 40) Travels dated were leave was incurred

PURCHASING

Conflict of Interest

- 1) Vendor address same as employee address
- 2) Vendor phone same as employee phone

Fraudulent vendor

- 3) More than one vendor with the same address
- 4) Vendors with P.O. Boxes, Drop Boxes or no address
- 5) Vendors with no phone numbers
- 6) Sequentially numbered invoice
- 7) Numerous invoices just below approval thresholds
- 8) Invoices with same dates and amounts
- 9) Invoices significantly greater than purchase order
- 10) Vendor names that SOUND LIKE well known vendors
- 11) Invalid FEID numbers
- 12) Deliver to address not entity address

Vendor Kickbacks/Bid Rigging

- 13) Contract award date precedes proposal due date (bid rigging)
- 14) Bid received date of awarded contract is always latest bid (bid rigging)
- 15) Bid Limits are exceeded (Total purchase greater than bid amount)
- 16) Purchase order date prior to bid date (bid rigging)
- 17) Unit price per part number is excessive for one vendor (Price Gouging)
- 18) Contracts just below bid limits (preferential buys)
- 19) Splitting contracts to avoid bid limits (preferential buys)
- 20) Purchase quantities exceed contract quantities (excess purchases)
- 21) Purchases do not result in a related increase in inventory levels (merchandise never shipped or under shipped)
- 22) Inventory levels continue to rise (excess purchases)
- 23) Duplicate invoice numbers (duplicate pays)
- 24) Duplicate date and invoice amounts (duplicate billings)
- 25) Increase in production costs due to increase in supply costs (inflated prices)

It would have been obvious to one skilled in the art at the time of the invention that the system and method for operating an electronic form system as taught by Vance et al. with its ability to check and enforce corporate policies (e.g. travel policies) would have benefited from enforcing any of a plurality of well known corporate policies including but not limited to determining if a business trip period is continuous in view of the teachings of Head; the resultant system and method enabling business to identify common business errors (i.e. potential violations of corporate policy).

Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 2, 16, and 19 Vance et al. does not expressly teach comparing a business trip period to a leave period as claimed.

Head teaches determining an actual business trip period according to a leave record and the predetermined business trip period (e.g. to determine if the business trip and the leave information overlap, Number 40) in an analogous art of business management for the purposes of catching common accounting/business errors.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for operating an electronic form system as taught by Vance

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et al. with its ability to check and enforce corporate policies (e.g. travel policies) would have benefited from enforcing any of a plurality of well known corporate policies including but not limited to determining if a business trip and leave overlapped in view of the teachings of Head; the resultant system and method enabling business to identify common business errors (i.e. potential violations of corporate policy).

Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 3-4 and 16 Vance et al. does not express teach leave request as claimed.

Head teaches determining the overlap between a business trip and leave, as discussed above (i.e. if the leave record corresponds to a leave period and the leave period is included in the predetermined business trip period).

Neither Vance et al. nor Head expressly teach subtracting the leave period from the predetermined business trip period to determine an actual business trip period or subsequently utilizing the predetermined business trip period to be the actual business trip period as claimed.

Official notice is taken that one of skilled in the art at the time of the invention would have known to subtract the overlapping leave amount from the business trip period in order to determine the actual duration of the business trip.

It would have been obvious to one skilled in the art at the time of the invention that the invention that the system and method for operating an electronic form system as taught by the combination of Vance et al. and Head with its ability to enforce corporate policies – such as identifying overlapping business and leave trips/travel would have benefited from further determining how much (duration) the leave and business trip and leave overlapped (e.g. by subtracting the leave length from the business trip length) in view of the teachings of official notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 5 Vance et al. teach a system and method further comprising receiving a command inputted from the user, before the predetermined business trip period, for modifying the business trip electronic form (Column 6, Lines 23-35; Figure 3, Element 68; Column 7, Lines 5-17, 48-53).

Regarding Claims 6 and 11 Vance et al. teach a system and method further comprising: determining whether the business trip electronic form is allowed (approved, accepted, etc.; Column 5, Lines 64-68; Column 6, Lines 1-35; Figure 3; Column 7, Lines 65-68), revising the business trip form if the business electronic form is allowed and blocking the business trip electronic form from being revised if the business trip electronic form is not allowed yet (Column 6, Lines 23-35; Figure 3, Element 68; Column 7, Lines 5-17, 48-53; Column 8, Lines 17-25).

Regarding Claims 7 and 12 Vance et al. teach a system and method further comprising receiving a command inputted from the user, before the predetermined business trip period, for cancelling the business trip electronic form (Column 6, Lines 23-35; Figure 3, Element 68).

Regarding Claims 8 and 13 Vance et al. teach a system and method further comprising determining if the business trip electronic form is allowed (Column 5, Lines 64-68; Column 6, Lines 1-35; Figure 3; Column 7, Lines 65-68), canceling the business trip electronic form if the business trip electronic form is allowed and blocking the business trip electronic form from being canceled in the business trip electronic form is not allowed yet (Column 6, Lines 13-35; Figure 3, Element 68).

Regarding Claims 9, 14, 17 and 20 Vance et al. teach a system and method further comprising showing a warning message (notification, alert) to the user if the

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business trip period violates a business policy (policy violation, exceptions, unauthorized trips, etc.; Column 2, Lines 14-23; Column 7, Lines 30-47; Column 8, Lines 26-33).

Vance et al. does not expressly teach that the violated policy includes a non-continuous business trip as claimed.

Head teaches a plurality of well known business policies/rules used to detect incorrect, inaccurate and/or fraudulent information in a business specifically Head teaches determining whether a predetermined business trip is continuous (Numbers 8, 13, 16, 34, 37) in an analogous art of business management for the purposes of catching common accounting/business errors.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for operating an electronic form system as taught by Vance et al. with its ability to check and enforce corporate policies (e.g. travel policies) would have benefited from enforcing any of a plurality of well known corporate policies including but not limited to determining if a business trip period is continuous in view of the teachings of Head; the resultant system and method enabling business to identify common business errors (i.e. potential violations of corporate policy).

Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it

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did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 10 and 18 Vance et al. teach a system and method for operating an electronic form system comprising:

- receiving a first business trip electronic form inputted from a user (Column 5, Lines 1-16; Figure 3, Element 68; Figure 4, Element 84, 120; Figure 2, Element 40, 50);
- reading and comparing a first and second business trip electronic form previously applied by the user (Column 2, Lines 15-24, 49-54; Column 6, Lines 40-55; Column 7, Lines 10-47; Column 11, Lines 14-19; Figures 8, 10, 13);
- storing the business first business trip electronic form (Figures 2, 13, Element 128).

Head teaches comparing business trip data (records) to determine if there is an overlap (duplicate, repeat; Numbers 8, 24, 24, 27) business trip in an analogous art of business management.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for operating an electronic form system as taught by Vance et al. with its ability to check and enforce corporate policies (e.g. travel policies) would have benefited from enforcing any of a plurality of well known corporate policies including but not limited to overlapping and/or duplicate business trips or expenses in

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view of the teachings of Head; the resultant system and method enabling business to identify common business errors (i.e. potential violations of corporate policy).

Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gadol, U.S. Patent No. 5,754,857, teach a system and method for managing the electronic business trip (travel) forms workflow (request, approval, expenses).

- Krenzke et al., U.S. Patent No. 6,338,097, teach a system and method for managing electronic forms including trip/travel, leave, time & attendance (timesheet) forms.

- Lawson et al., U.S. Patent Publication No. 2002/0152101, teach a system and method for managing a business trip (travel) electronic form system comprising trip requests, trip constraints (policies, rules, et.), manager review and approval of current trips wherein the manager references historical trip data.

- JP200259724A, teach a system and method for managing electronic business trip forms including business trip applications/requests.

- JP 2003196446A, teach a system and method for managing electronic business trip forms.

- JP2003344699A, teach a system and method for managing electronic business trip forms.

- McCrindell, Travel Expert System (1993), teach a system and method for managing business travel comprising: business trip electronic forms (travel requests), verifying/checking business travel requests against corporate policies/rules,

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alerting/notifying users of business travel forms that do not match corporate policies, and the review and approval of business travel trip requests by managers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3624